



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kai FABIAN et al.

Serial No.: 10/089,223

Group Art Unit: 1621

Filed: September 17, 2002

Examiner: PRICE, Elvis O

For: METHOD FOR BROMINATING ORGANIC COMPOUNDS

DECLARATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

I, the undersigned, being duly warned, hereby declare as follows.


1. I am responsible for this patent application as a member of the Patent Department of Merck of Darmstadt, Germany.
2. An Office Action was issued on June 2, 2003, in the above-identified application to which a response was due on July 2, 2003.
3. Merck, under its normal business practices, has a patent committee made up of personnel from the Patent Department, business units and research departments.
4. The patent committee meets quarterly to discuss the patent portfolio of the company, and to make decisions about the fate of company owned intellectual property, including the above-identified patent application.
5. Such a meeting was held on 29.01.2003, where a person named Dr. Michael Schmidt, whose job is to organize patent affairs for the division NB-SC, informed the patent committee that this application should be abandoned.
6. In a letter dated June 5, 2003, a letter was sent to counsel prosecuting this application in the US (MWZB hereinafter) indicating that Merck is no longer interested in this application.

7. On April 28, 2005 it was discovered that this application was abandoned as a result of a mistake.
8. Upon internal investigation it was discovered, that Dr. Schmidt's information indicating that the application should be abandoned based on incomplete and incorrect information. The official in the interested R&D department who had authority to authorize abandonment was not consulted regarding the value placed on this application and the needs of the company. Under company practice the latter person should have been consulted prior to abandonment of this application. As a result, the application was abandoned on incorrect and incomplete information. The apparent reason for this error is that Dr. Schmidt did not ask whether there were further processes in which the bromination was planned to be carried out according to the present application. Additionally, Dr. Schmidt didn't ask whether there were liabilities versus third parties, therefore he didn't know that there were negotiations for giving a license for this application. Since the Patent Department "Patents Chemicals" was not involved in these negotiations, no further person of the patent committee could intervene in order to avoid the decision to abandon this application.
9. As a result of the above facts, it can be seen that this application was abandoned by the assignee unintentionally.
10. On April 28, 2005, in a letter to MWZB, applicants inquired whether it is possible to revive this patent application.
11. A letter dated May 27, 2005, from MWZB to applicants discussed the possibility of revival if the application was abandoned unintentionally.
12. On May 30, 2005, in a letter to MWZB, applicants indicated that the application was abandoned as a result of an error.
13. A letter dated June 23, 2005, from MWZB to applicants indicated that a reply must also be filed to the Office Action dated June 2, 2003, making an election as required therein, when filing a petition for the revival of the application.

14. On June 28, 2005, in a letter to MWZB, applicants made an election.
15. On June 29, 2005, a reply was filed along with a petition for the revival of the application.
16. In view of the above, the entire period of delay in filing the papers for revival of this application from the time of abandonment was unintentional.
17. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Merck Patent GmbH

i. V.



Name: Annette Wagner
Title: Authorized Employee

Date: November 15, 2005